

REMARKS

By this amendment, Applicant amends claims 15 and 23–25 to set forth the invention with more particularity. No new matter is added by this amendment. Claims remaining in this application are:

Independent claims: 15, 19, 23–26

Dependent claims: 7, 8, 12, 14, 16–18, 20–22, 27, 28

In response to Examiner’s rejection under 35 U.S.C. § 101, Applicant has amended claims 15, 23, 24, and 25 to recite a method for “conducting” a game of chance. Applicant respectfully submits that these claims, as amended recite patentable subject matter. As Examiner has correctly pointed out, a method is patentable if it recites a method having “a concrete, tangible, and useful result.” However, Applicant submits that it does not necessarily follow that a method must include “an array of indicia, such as a virtual deck of cards, being stored in the physical memory of a gaming device, or being displayed on a physical playing table, such as that found in a casino” as asserted by Examiner. Such an approach was expressly rejected by the Federal Circuit when it stated that “[t]he question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to — process, machine, manufacture, or composition of matter — but rather on the essential characteristics of the subject matter, in particular, its practical utility.” State Street Bank & Trust Co., v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998). In other words, it is not necessary that a method be embodied in a “machine” or be played at a “table” as Examiner appears to assert. Rather, the determination of patentability is whether the method

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produces “a concrete, tangible, and useful result,” regardless of whether the method can be played at a “machine” or a “table.” Applicant respectfully submits that such an artificial requirement that a method recite a “machine” or a “table” runs contrary to State Street Bank.

Applicant submits that the subject matter of the amended claims satisfies both of these tests. The steps of the claimed method lead from the concrete, tangible step of receiving a wager from a player through the concrete, tangible step of selecting data from an inventory of game indicia and producing a game outcome to the concrete, tangible step of issuing a reward based on the game outcome and the wager. In other words, the claimed method is a concrete, tangible, and useful method for conducting a series of steps to determine whether a wager input leads to an award output. This is not strictly an algorithm or abstract concept or idea, but a series of concrete steps (including, for example, “randomly selecting,” “displaying,” “depleting,” and “reconstituting”) performed on an inventory of indicia that define how the determination of the award output is made.

To clarify that these steps are not merely the manipulation of abstract ideas, Applicant has amended the claims to recite “receiving” a wager from a player. Applicant respectfully submits that methods in which a wager is “received” and a series of steps is “conducted” to determine whether a wager is to be rewarded, even in the absence of specific hardware, is statutory subject matter as evidenced by any number of U.S. patents, including, for example, U.S. Patent Nos. 6,817,614 and 6,869,360. Therefore, Applicant respectfully submits that the claims recite statutory subject matter and, as such, are in condition for allowance.

Turning to Examiner’s rejection under 35 U.S.C. § 103(a), Applicant respectfully submits

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that Kinoshita and Richardson do not disclose what Examiner asserts they do. Applicant directs Examiner's attention to the Appeal Decision in Appeal No. 2005-1071 (attached hereto as Exhibit A) for the interpretation by the Board of Patent Appeals and Interferences of Kinoshita and Richardson. This appeal was directed to a related application in that the appealed application was directed to a poker game with continuous depletion, whereas the present application is directed to a slot game with continuous depletion. In the related application, the prior examiner had rejected claims with similar claim limitations based on Fuchs (U.S. Patent No. 5,630,753), alone or in combination with Kinoshita and Richardson. In the appeal decision, the BPAI examined the disclosure of Kinoshita and stated:

We find no teaching in Kinoshita that the deck is not reconstituted and randomized (i.e. allowed to deplete) between hands of the poker game. Further, we find that Kinoshita does not teach displaying winning outcomes eliminated because of depletion. We find that Kinoshita teaches that the outcomes are eliminated based upon the hold decisions made by the player *and not the depletion of the deck as claimed. Thus, we find that Kinoshita provides no teaching or suggestion of displaying winning outcomes eliminated because of depletion.* Appeal Decision, p. 9, ll. 17–24 (emphasis added).

With respect to Richardson, the BPAI examined claims reciting “the limitation of displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion,” and specifically stated “we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to include this limitation.” Appeal Decision, p. 10, ll. 13–18.

Independent claim 15 recites that “randomly selecting and displaying a plurality of individual indicia from the inventory, the combination of indicia selected and displayed defining at least one hand outcome and depleting said selected indicia from play for subsequent hands” and “displaying any scheduled winning outcomes eliminated as a result of depletion of said indicia inventory.” Since the BPAI has held that neither Kinoshita nor Richardson teaches or suggests “depletion of the data representing the cards in the deck over several hands” or “displaying outcomes eliminated due to depletion,” Applicant submits that claim 15 is allowable over Kinoshita, alone or in combination with Richardson.

Independent claim 19 recites a processor “configured to remove said selected indicia from selection for future hands” and “control the display to display prior to the play of the next hand data corresponding the remaining inventory of indicia sets depleted of said displayed game indicia including the display of data corresponding to the depletion of indicia from said inventory such that one or more scheduled winning outcomes are unavailable due to depletion.” Since the BPAI has held that neither Kinoshita nor Richardson discloses or suggests the claim limitations of depletion over several hands or displaying the depletion of data or the outcomes eliminated (i.e. unavailable) due to depletion, Applicant submits that claim 19 is allowable over Kinoshita, alone or in combination with Richardson.

Independent claim 23 recites “displaying to the player information regarding any winning outcomes eliminated by said depletion of indicia” and “depleting said displayed individual indicia from the inventory available for play of the next hand.” Since the BPAI has held that neither Kinoshita nor Richardson discloses or suggests the claim limitations of depletion over

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several hands or displaying outcomes eliminated as a result of depletion, Applicant submits that claim 23 is allowable over Kinoshita, alone or in combination with Richardson.

Independent claim 24 recites “depleting said displayed indicia from the inventory available for play of subsequent hands” and “displaying to the player any winning outcomes eliminated by depletion of the indicia and the number of each indicia remaining in each indicia set in the inventory as depleted of the prior selected and displayed inventory.” Since the BPAI has held that neither Kinoshita nor Richardson shows or suggests depletion over several hands or displaying winning outcomes eliminated as a result of depletion, Applicant submits that claim 24 is allowable over Kinoshita, alone or in combination with Richardson.

Independent claim 25 recites “depleting said displayed indicia from the inventory available for play of subsequent hands” and “displaying the number of each indicia remaining in the sets in the inventory as depleted of the prior selected and displayed inventory and any winning outcomes eliminated as a result of depletion.” Since the BPAI has held that neither Kinoshita nor Richardson disclose or suggest the limitations of depleting inventory over several hands or displaying winning outcomes eliminated as a result of depletion, Applicant submits that claim 25 is allowable over Kinoshita, alone or in combination with Richardson.

Independent claim 26 recites a processor configured to “preclude said selected indicia from selection from said inventory” and “control the display to display prior to play of the next hand any scheduled winning outcomes eliminated by depletion of said indicia.” Since the BPAI has held that neither Kinoshita nor Richardson disclose or suggest the limitations of depleting inventory over several hands or displaying winning outcomes eliminated as a result of depletion,

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Applicant submits that claim 26 is allowable over Kinoshita, alone or in combination with Richardson.

The remaining claims depend directly or indirectly from independent claims 15, 19, 23, 24, 25, or 26. Consequently, the remaining claims are allowable as depending from allowable independent claims.

### CONCLUSION

For the reasons advanced above, it is submitted that all pending claims are in condition for allowance. Allowance of all pending claims is requested. Should Examiner believe that a telephone interview would facilitate allowance of the pending claims, the undersigned would invite and request such an interview.

Respectfully submitted,  
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Dated: May 17, 2007

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